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09/629,175

07/31/2000

Ophir Frieder

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7590 05/05/2009  
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EXAMINER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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Ex parte Frieder et al.

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Appeal 2007-1954  
Application 09/629,175  
Technology Center 2100

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Mailed: May 5, 2009

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REQUIREMENT FOR ADDITIONAL INFORMATION

This Requirement for Additional Information is in response to Appellants' "Objection to Publication Under 37 CFR 41.6(a)(2)" ("Objection"), filed by Appellants on April 13, 2009. The Objection was submitted in response to the "Order Pursuant to 37 C.F.R. § 41.6(a)(2)" ("Publication Order") entered by the Appeals Program Manager of the Board of Patent Appeals and Interferences ("Board"), on February 12, 2009, notifying Appellants of the Board's intention to publish the Decision on Appeal in this application.

FINDINGS

1. The present application was filed on July 31, 2000, and therefore is exempt from publication under 35 U.S.C. § 122(b)(1). *See*, MPEP § 1120.

2. On February 3, 2009, a panel of the Board entered a Decision on Appeal in this application affirming-in-part the Examiner's rejections and adding new grounds of rejection.
3. The Publication Order, entered February 12, 2009, advised Appellants that the Office intended to make the Decision on Appeal "available for public inspection pursuant to 37 C.F.R. § 41.6(a)(2)." The Publication Order also granted Appellants a period of two months from the date of its entry in which to file an objection to such action.
4. On April 3, 2009, Appellants filed a Request for Continued Examination.
5. The Objection, filed April 13, 2009, objects to the publication of any portion of the Decision on Appeal, contending that:

A substantial portion of the text of the February 3, 2009 opinion relates to confidential and/or secret information. In addition, it is believed that publication of the decision could cause other portions of the prosecution history to be prematurely released.
6. With respect to objections to publication of Board opinions, 37 C.F.R. § 41.6(a)(2) specifies that an objecting party must:

object in writing on the ground that the action [*i.e.*, Decision on Appeal,] discloses the objecting party's trade secret or other confidential information and state[] with specificity that such information is not otherwise publicly available. If the action discloses such information, the party shall identify the deletions in the text of the action considered necessary to protect the information. If the affected party considers that the entire action must be withheld from

the public to protect such information, the party must explain why.

### DISCUSSION

In support of the Objection, Appellants contend that "a substantial portion of the text [of the Decision on Appeal] relates to confidential and/or secret information." This contention is insufficient under Rule 41.6(a)(2) to warrant setting aside the Publication Order because such contention does not identify the alleged confidential and/or secret information, or state that such information is not otherwise publicly available. Further, Appellants do not identify deletions in the text considered necessary to protect the alleged confidential and/or secret information, or explain why it is necessary to withhold from publication the entire 54 page Decision on Appeal to protect such information.

Appellants also express concern that publication of the Decision on Appeal will result in release of the prosecution history of the application. The application appears to be confidential under 35 U.S.C. § 122 and appropriate Office rules. Release of the prosecution history, beyond the Decision on Appeal, is not a matter under consideration.

### REQUIREMENT FOR ADDITIONAL INFORMATION

Appellants' Objection to the Publication Order is incomplete. In order to fully evaluate the Objection, Appellants are required to provide the following additional information:

1. Specifically identify, by page and line number, the portions of the the Decision on Appeal alleged to be confidential and/or secret;

2. State whether the following have become publicly available: (1) any of the alleged confidential information in the Decision on Appeal and (2) the content of the specification and drawings of Application 09/629,175;
3. Explain the steps Appellants have taken to keep the above information confidential; and
4. If Appellant's persist in the objecting to publication, provide:
  - a. A redacted copy of the Decision on Appeal that Appellants consider suitable for publication; or
  - b. A detailed explanation of why it is necessary to withhold from publication the entire Decision on Appeal to protect such information.

Appellants are given a period of 30 days to submit this required additional information. 35 U.S.C. § 133. This period may not be extended under the provisions of 37 CFR § 1.136(a). See 37 CFR 1.136(a)(1)(i).



Michael R. Fleming  
Chief Administrative Patent Judge

Appeal 2007-1954  
Application 09/629,175

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